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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,668	07/21/2003	Yasuhiro Yoshioka	FSF-031391	3824
7590	10/04/2004		EXAMINER	CHEA, THORL
Sheldon J. Moss c/o Yumi Yerks Apartment #412-North 2111 Jefferson Davis Highway Arlington, VA 22202			ART UNIT	PAPER NUMBER
1752				
DATE MAILED: 10/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/622,668	YOSHIOKA ET AL. <i>g</i>	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 July 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 07212003.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language “the reducing agent which forms a dye has higher activity than that of the reducing agent which does not form a dye” is unclear with respect to the term “higher activity” since there is no basis for comparison of such activity. See the language in claim 1.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cerquone et al (US Patent No. 4,021,240). See the material in

the abstract, and column 25-30 wherein the material contains photographic silver halide, silver salt oxidizing agent, binder, reducing agent and a coupler; see also column 6, lines 30-68 which discloses the use of the reducing agent that does not adversely affect the desire color image such as phenolic leuco dye reducing agent. It is believed that the reducing agent react with silver salt oxidizing agent to produce a desired dye in the imagewise exposed area of the photothermographic element, and the latent image silver produce upon imagewise exposure catalyzes the reaction between the reducing agent and the silver salt oxidizing agent. Accordingly, the worker of ordinary skill in the art would have envisaged that the use of a reducing agent for silver salt oxidizing agent is necessary to catalyzes the reaction the reaction between the reducing agent and the silver salt oxidizing agent is necessary, and would have used thereof in the photothermographic material, and therefore, anticipate the material of the claimed invention. Alternatively, the worker of ordinary skill in the art at the time the invention was made to the color reducing agent taught therein with an expectation of achieving a similar material. The color developing agent react with color coupler, but not with silver salt reducing agent. Therefore, it has activity higher than that of reducing agent for silver salt oxidizing agent with respect to color coupler.

6. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 10096310 (EP'310).

The EP'310 discloses a photothermographic material substantially as claimed. See the phenol compound on page 3, compound (I) and the description of -L- and R1 to R8 on page 5 such as L is -CHR⁹-, R9 is hydrogen or alkyl; R1, R8 represent secondary alkyl group or a tertiary alkyl group; R2, R4, R5, R7 represent hydrogen, halogen, or an alkyl group, more preferably

hydrogen; R1, R3, R6, R8 represent an alkyl group, more preferably, a primary group having 1-20 carbon atoms, a secondary alkyl group having 3-20 carbon atoms, or tertiary group having 4-20 carbon atom, and the substituent thereof includes alkoxy group , aryloxy group, hydroxyl group, acyloxy group, amino group, heterocyclic group. See also the compound on page 9, I-22 that contains $-\text{CH}_2\text{OCH}_3$; compound (I-24) on page 10; the compound (I-12) on page 8. see the other additive such as compound having phosphoryl group on pages 20-34; the halogenated compound on pages 60, [0242], [0243]; the amount of reducing agent on pages 11, [0039], [0040]; the amount of silver salt on page 35, [0074]; the toning agent and the ultrahigh contrast developer on page 41; the hydrazine derivative on page 49, [0167], [0168]; and time and temperature processing on page 53, [0210]. The EP'310 differs from that of the present claimed invention is the combination of agents of two reducing agents comprising a reducing agent which doe not form a dye during thermal development and the reducing agent which form a dye during thermal development, and the reducing agent which forms a dye has higher activity than that of the reducing agent which does not form a dye, but the reducing agents of the claimed invention are within the scope of the compound of formula (I) on page 3 of EP'310 on page 3, described above. The properties with respect to the formation with a dye are considered as inherent to the reducing agent of the EP'310. The reducing agent taught in EP'310 provide a photothermographic material with sufficient image density and image storage stability could be remarkably improved without substantially degrading the reducing property. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use one or more compound within the scope of formula (I) of EP'310 with an expectation of achieving a highly useful material with sufficient image density and image storage stability could be

remarkably improved without substantially degrading the reducing property, and thereby provide a material as claimed.

Conclusion

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *TC*
September 25, 2004

Thorl Chea
Primary Examiner
Art Unit 1752

